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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,431	07/13/2001	Bettina Jackwerth	H3739PCT/US	4200

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COGNIS CORPORATION  
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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1619

DATE MAILED: 01/15/2002

*S*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/831,431

Applicant(s)

JACKWERTH ET AL.

Examiner

Gina C. Yu

Art Unit

1617

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12-13-2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of Request for Reconsideration filed on December 13, 2001.

Claims 11-22 are pending and stand rejected.

#### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prat et al. (U.S. Pat. No. 5,718,891) in view of Ponsati Obiols et al. (U.S. Pat. No. 5,880,299) and Inman et al. (U.S. Pat. No. 5,935,561).

The rejection is maintained for reasons of record in the prior office action.

#### *Response to Arguments*

Applicant's arguments have been fully considered but they are not persuasive as discussed below.

Applicants argue that the rejection under 35 U.S.C. § 103(a) made over Prat in view of Ponsati Obiols and Inman lacks any evidence as to why a routineer would be motivated to combine the references to produce the claimed invention. Specifically, applicants argue that both Prat and Ponsati Obiols teach very effective hair care compositions and the routineer would not be motivated to modify their inventions. In applicants' argument against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on *combinations* of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the motivation to combine the references are found in Inman, which teaches that its

Art Unit: 1617

use of organic hair conditioning oils in combination with synthetic esters provide beneficial properties to hair. It must be also recognized that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found *either* in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Therefore, the fact that Prat and Ponsati Obiols are silent about any defects in or need to modify their inventions alone does not necessarily negate the obviousness of incorporating the hair conditioning oil of Inman for further improvement, when the motivation to do so is clearly found in Inman.

Applicants also argue that the routineer would not have expected that the incorporation of Inman's organic oils into the formulations of Prat and Ponsati Obiols would produce an effective hair care properties because the beneficial properties of Inman's invention would be realized only in the specific combinations of certain organic conditioning oils, synthetic esters, and cationic polymers. Specifically, applicants note that without Inman's combination the composition would render undesirable properties such as "slimly, greasy-feeling" to the hair. Examiner respectfully disagrees with applicants' position. Even if the routineer took the teaching to mean that only the specific formulation of Inman would provide the beneficial properties to hair, the obviousness rejection could not be overcome because the scope of the applicants' claimed invention is so broad as to include the presence of other components, such as the synthetic esters and cationic conditioning polymers of Inman. Thus, the rejection is proper.

Furthermore, examiner notes that Inman in fact teaches that the said undesirable properties (slimy or excessively conditioned feel) are realized “especially when the conditioning oils is used in combination with a cationic conditioning polymer.” From reading the background of the invention in col. 1, lines 6 – 67, it would have been obvious to one of skill in the art that using organic conditioning oils in shampoo formulation has been known in the art. Thus examiner takes the position that the teaching in col. 1, lines 53 – 57 does not necessarily teach away from incorporating the organic conditioning oil into the inventions in Prat and Ponsati Obiols.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

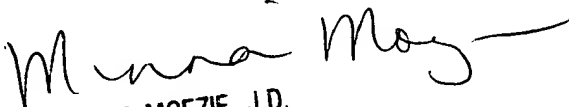
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu at 703-308-3951. If the attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Minna Moezi can be reached

Art Unit: 1617

on 703-308-4612. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
January 12, 2002

  
MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
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